

-8-

REMARKS

The Examiner has revised the current rejection in light of new prior art and a reformulated rejection. While applicant continues to disagree with the Examiner, applicant has incorporated the subject matter of at least one dependent claim into each of the independent claims in the spirit of expediting the prosecution of the present application. Since the subject matter of such dependent claim(s) was already considered by the Examiner, it is asserted that such claim amendments would not require new search and/or consideration.

The Examiner has rejected Claims 1-32 and 34 under 35 U.S.C. 103(a) as being unpatentable over Nessett et al. (U.S. Patent No. 5,968,176) and further in view of Reid et al. (U.S. Patent No. 6,182,226) in view of Kephart (U.S. Patent No. 5,452,442). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove. Specifically, applicant has amended each of the independent claims to include the subject matter of Claim 32.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

With respect to the first element of the *prima facie* case of obviousness and, in particular, the obviousness of combining the aforementioned references, the Examiner argues that a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Nessett by employing a firewall capable of

-9-

virus scanning to scan for known types of malicious programs or data, as in Reid et al., in order to further improve the level of security provided by a firewall to prevent malicious attacks from incurring on a target system. The Examiner also argues that a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Nessett in view of Reid et al., by scanning for virus signature files, such as disclosed by Kephart, in order to accurately monitor for viruses, and distinguish false alarms from regularly executing programs. To the contrary, applicant respectfully asserts that it would not have been obvious to combine the teachings of the Nessett, Reid and Kephart references, especially in view of the vast evidence to the contrary.

For example, Nessett relates to a Network Interface Card (NIC) firewall, while Reid relates to external firewalls. To simply glean features from a NIC firewall, such as that of Nessett, and combine the same with the *non-analogous art* of external firewalls, such as that of Reid would simply be improper. External firewalls protect multiple computers, while a NIC firewall protects the computer to which it is attached. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) In view of the vastly different types of problems a NIC firewall addresses as opposed to an external firewall, the Examiner's proposed combination is inappropriate.

In addition, contrary to the Examiner's arguments, applicant's claimed feature would have been unobvious in view of Reid, since Reid' external firewalls *teach away* from any sort of processor positioned on a network adapter coupled between a computer and a network. In re Hedges, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986).

Further, as noted above, Nessett relates to a firewall, while Kephart relates solely to virus scanning. To simply glean features from a firewall, such as that of Nessett, and

-10-

combine the same with the *non-analogous art* of virus scanners, such as that of Kephart would simply be improper. Firewalls protect computers using rule-based filtering, while a virus scanner performs signature-based scanning. In view of the vastly different types of problems a firewall addresses as opposed to a virus scanner, the Examiner's proposed combination is again inappropriate.

To this end, applicant respectfully asserts that it would not have been obvious to combine the teachings of the Nessett, Reid and Kephart references, as noted above. Nevertheless, despite such paramount deficiencies and in the spirit of expediting the prosecution of the present application, applicant has included the subject matter of Claim 32 et al. in each of the independent claims.

With respect to the subject matter of Claim 32 (now incorporated into each of the independent claims), the Examiner has relied on Kephart to meet applicant's claimed technique "wherein the virus signature files are stored on non-volatile solid state memory on the network adapter." Further, the Examiner argues that "Nessett et al. in view of Reid et al. in view of Kephart further disclose that it would have been obvious to store the signature files on a non-volatile solid state memory on the network adapter since virus scanning is performed on the network adapter, it would be obvious that the signature files be located along with the virus scanner."

Applicant respectfully disagrees. Virus scanning on a network adapter, in and of itself, in no way makes it obvious that "the signature files be located along with the virus scanner," as purported by the Examiner. Just by way of example, the files may be stored on a host computer and retrieved as necessary to perform scanning.

Further, it appears that the Examiner has still not taken into consideration the full weight of applicant's claims. Specifically, the Examiner's proposed combination fails to even suggest a technique "wherein the virus signature files are stored on non-volatile solid state memory on the network adapter" (emphasis added). Such non-volatile feature

-11-

provides numerous optional advantages such as scanning at boot-up (before signatures can be loaded into memory post-boot-up), etc.

Thus, with respect to the third element of the prima facie case of obviousness, applicant respectfully asserts that the prior art references, when combined, fail to teach or suggest all of the claim limitations. A notice of allowance or a specific prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

The Examiner's rejections remain deficient with respect to the dependent claims, since such rejections also do not meet each and every element of the prima facie case. For example, with respect to dependent Claim 6 et al., the Examiner has relied on Col. 7, lines 9-21 in Nessett to make a prior art showing of applicant's claimed technique "wherein the manner in which the scanning is performed is capable of being user-configured." Applicant respectfully asserts that such excerpt merely discloses filtering rules. Clearly, filtering rules do not meet applicant's specific claim language, namely "the manner in which the scanning is performed" (emphasis added) since filtering rules only identify types of data that may be allowed access, and not scanning, as claimed.

With respect to Claim 11 et al., the Examiner has relied on Col. 23, lines 18-26 in Nessett to make a prior art showing of applicant's claimed technique "wherein the processor is capable of scanning received packets that are of interest." The Examiner further states that scanning is implied from the ability to distinguish between the different protocols. Applicant asserts that the Examiner has failed to consider the full weight of applicant's claim language. Applicant claims "scanning received packets that are of interest" (emphasis added), and not simply scanning received packets to determine if they are of interest, as in Nessett.

With respect to Claim 30, the Examiner has relied on Col. 17, lines 9-21 in Nessett to make a prior art showing of applicant's claimed technique "wherein the content scanning enforces operational policies of an organization." Applicant

-12-

respectfully asserts that such excerpt only generally teaches managing security policy data. Clearly, managing security policy data for the operation of security systems, as in Nessett, does not meet any sort of content scanning, and especially not content scanning that "enforces operational policies in an organization," as specifically claimed by applicant.

Again, a notice of allowance or a specific prior art showing of each of such claim limitations, in the context of the remaining elements, is respectfully requested.

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

Reconsideration is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P056/01.187.01).

Respectfully Submitted,
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